

This Opinion is Not a
Precedent of the TTAB

Mailed: February 7, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re HD Medical Electronic Products Inc.
—

Serial No. 87207915
Serial No. 87207919
Serial No. 87207921
(Consolidated)
—

HD Medical Electronic Products Inc., pro se.

Christina Calloway, Trademark Examining Attorney, Law Office 122,
John Lincoski, Managing Attorney.

—
Before Zervas, Bergsman, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

HD Medical Electronics Products Inc. (“Applicant”), appearing pro se, seeks registration on the Principal Register of the proposed standard character marks MR1109, MR1108, and MR1107, all for “permanent magnet motors” in International Class 7.¹

¹ Application Serial Nos. 87207915, 87207919, and 87207921 were filed on October 19, 2016 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claimed first use of the proposed marks and first use in commerce at least as early as May 8, 2008.

The Trademark Examining Attorney has refused registration of each of Applicant's proposed marks under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127, on the ground that the proposed marks fail to function as marks because they are merely model designations.

Applicant appealed when each of the three refusals were made final. The appeals have been consolidated, 10 TTABVUE,² and Applicant and the Examining Attorney have filed briefs in each appeal. We affirm the three refusals to register.

I. Prosecution Histories and Record on Appeal³

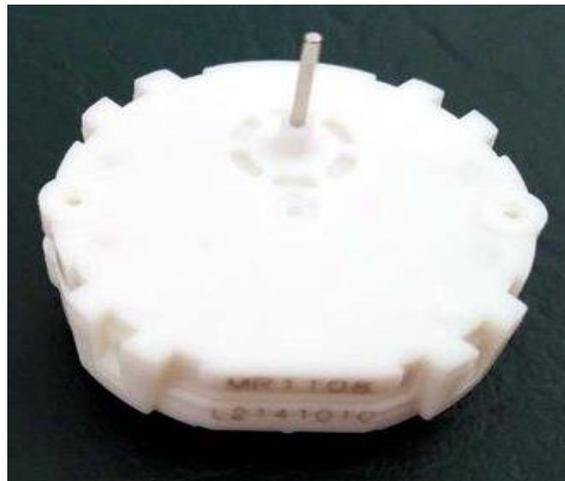
We summarize below the prosecution histories of the involved applications because they provide useful background to our analysis of the issues on appeal.

The Examining Attorney issued first Office Actions in each case in which she refused registration of Applicant's proposed marks on the grounds that the marks did not appear on Applicant's specimens and that the specimens did not show use of the mark in connection with the goods, and issued advisories that upon the consideration of substitute specimens, registration might be refused on the ground that the proposed marks merely identified a model designation and did not function as

² Citations in this opinion to the briefs and other materials on appeal refer to TTABVUE, the Board's online docketing system. *Turdin v. Tribolite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear. Unless otherwise indicated, citations are to the TTABVUE docket in Application Serial No. 87207915.

³ Citations in this opinion to the application record are to pages in the Trademark Status & Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

marks.⁴ Applicant responded to each Office Action by arguing that it had “established a positive reputation in our industry for our part number,”⁵ and by submitting substitute specimens, two of which showed the applied-for marks:⁶



⁴ February 7, 2017 Office Actions at TSDR 1.

⁵ August 7, 2017 Responses to Office Action at TSDR 1.

⁶ The substitute specimen in Application Serial No. 87207921 showed the alpha-numeric WR 1107. *Id.* at TSDR 2 (Serial No. 87207921).

⁷ *Id.* at TSDR 2 (Application Serial No. 87207919).

⁸ *Id.* at TSDR 2 (Application Serial No. 87207915).

The Examining Attorney then issued final Office Actions maintaining both grounds for refusal of registration and continuing the model designation advisories.⁹ Applicant requested reconsideration in all three cases, submitting the substitute specimens displayed below:



⁹ September 1, 2017 Office Actions at TSDR 1.

¹⁰ February 28, 2018 Request for Reconsideration at TSDR 2-3 (Serial No. 87207915).

¹¹ February 28, 2018 Request for Reconsideration at TSDR 2-3 (Serial No. 87207919).

¹² February 28, 2018 Request for Reconsideration at TSDR 2-3 (Serial No. 87207921).

The Examining Attorney then issued superseding non-final Office Actions in all three cases in which she withdrew the refusals based on Applicant's failures to show the proposed marks on the specimens and issued refusals based on the ground that the specimens showed the proposed marks as merely model designators.¹³ The Examining Attorney requested certain information regarding Applicant's specimens pursuant to Trademark Rule 2.61(b), 37 C.F.R. § 2.61(b), and made of record pages from Applicant's website and third-party various webpages referring to the proposed marks as model or part numbers.¹⁴ We reproduce below excerpts from the webpages (all emphasis supplied by the Examining Attorney):



¹³ March 28, 2018 Office Actions at TSDR 1.

¹⁴ *Id.* at TSDR 2-10 (Serial No. 87207915), 2-11 (Serial No. 87207919), and 2-9 (Serial No. 87207921).

¹⁵ *Id.* at TSDR 2 (Serial Nos. 87207915, 87207919, and 87207921 (mcmotorusa.com)).

16

Product description

Part number MR1109 stepper motor. Compatibility: New generation steppers perfectly replace for the Switec/Juken X27.168, X25.168, XC5.168 and X15.168 that are in your cluster from 2003 to 2006, GM GMC cars and trucks Fixed problems like (caused by Motor Stepper): Gauge's sticking, shuttering, chatters, inaccurate, Gauge giving false readings, staying pegging out Gauge dead, etc Features: work in any gauge position and are the latest and greatest. Each Gauge has a stepper motor and the item will fit almost all Gauges. Quality Warranty, Money Back Guarantee Sepcification: Working Voltage: 5 to Voltage. Low current consumption: less than 20mA, 5V, 2x100mW. Directly driven by a controller Notice: Please make sure you can handle this work, it may need some professional equipment and electronic knowledge of PC Boards. We have professional Manual and Drawing on how use it, email us if you need one We are not responsible for any damages caused by the installation of these motors. MR1109 cluster stepper motor for your vehicles or cars.

17

Product information

Technical Details

| | |
|-------------------|--------|
| Item model number | MR1109 |
| Wireless Remote | No |

18

¹⁶ *Id.* at TSDR 3 (Serial Nos. 87207915, 87207919, and 87207921).
¹⁷ *Id.* at TSDR 4 (Serial Nos. 87207915, 87207919, and 87207921).
¹⁸ *Id.* at TSDR 5 (Serial Nos. 87207915, 87207919, and 87207921).

| Item specifics | | | |
|--------------------------------|--------------------|---------------------------|------------------------------|
| Condition: | New | Brand: | MR 1108 MCR 1109 X27168 TYPE |
| Surface Finish: | White | Manufacturer Part Number: | MR11058 MR1109 |
| Warranty: | Yes | Interchange Part Number: | MR1109, MR1108 |
| MPN: | MCR X27168 Type | Other Part Number: | MR1108 MR1109 |
| OE Spec or Performance/Custom: | OE Spec | Placement on Vehicle: | Front |
| Display Type: | Instrument Cluster | UPC: | Does not apply |



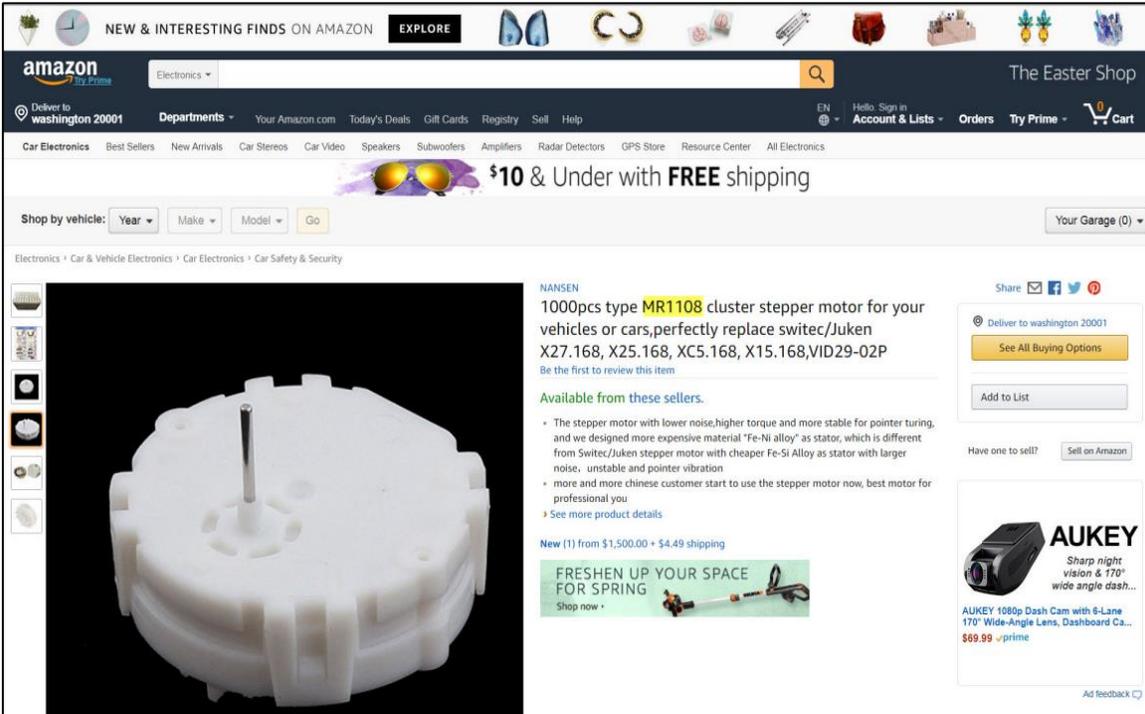
ASI Automotive Scientific Inc.

HOME ABOUT US SHIPPING PAYMENT RETURNS FAQ WARRANTY FORMS CONTACT US



Electronic Auto Parts

19



NEW & INTERESTING FINDS ON AMAZON EXPLORE

amazon by Prime

Electronics

Deliver to washington 20001

Departments - Your Amazon.com Today's Deals Gift Cards Registry Sell Help

EN Hello, Sign in Account & Lists Orders Try Prime Cart

Car Electronics Best Sellers New Arrivals Car Stereos Car Video Speakers Subwoofers Amplifiers Radar Detectors GPS Store Resource Center All Electronics

\$10 & Under with FREE shipping

Shop by vehicle: Year Make Model Go Your Garage (0)

Electronics > Car & Vehicle Electronics > Car Electronics > Car Safety & Security

1000pcs type MR1108 cluster stepper motor for your vehicles or cars, perfectly replace switec/Juken X27.168, X25.168, XC5.168, X15.168, VID29-02P

Be the first to review this item

Available from these sellers.

- The stepper motor with lower noise, higher torque and more stable for pointer tuning, and we designed more expensive material "Fe-Ni alloy" as stator, which is different from Switec/Juken stepper motor with cheaper Fe-Si Alloy as stator with larger noise, unstable and pointer vibration
- more and more chinese customer start to use the stepper motor now, best motor for professional you

See more product details

New (1) from \$1,500.00 • \$4.49 shipping

FRESHEN UP YOUR SPACE FOR SPRING Shop now

Share

Deliver to washington 20001

See All Buying Options

Add to List

Have one to sell? Sell on Amazon

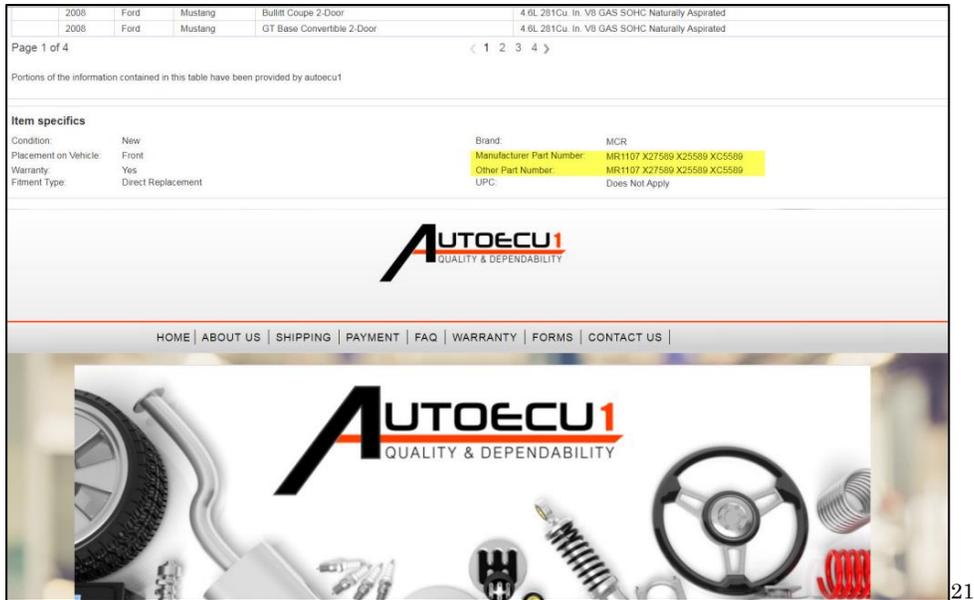
AUKEY Sharp night vision & 170° wide angle dash... AUKEY 1080p Dash Cam with 6-Lane 170° Wide-Angle Lens, Dashboard Ca... \$69.99 prime

Ad feedback

20

¹⁹ *Id.* at TSDR 10 (Serial No. 87207915).

²⁰ *Id.* at TSDR 4 (Serial No. 87207919).



Applicant traversed the refusals to register and provided information in response to the Examining Attorney’s request.²² Applicant stated that its “goods are not sold to the public, due to being industrial parts” and are “sold exclusively through Distributors, Dealers, and offered at Trade Shows only,” and that its additional substitute specimens submitted with the responses (portions of which are shown below) showed the display of the goods at the Specialty Equipment Market Association (“SEMA”) trade show in Las Vegas, Nevada:²³

²¹ *Id.* at TSDR 5 (Serial No. 87207921).

²² September 25, 2018 Responses to Office Actions at TSDR 1 (Serial Nos. 87207915, 87207919, and 87207921).

²³ *Id.*



24

The Examining Attorney then made final the failure-to-function refusals.²⁵ Applicant purported to request reconsideration, making of record yet another specimen of use of the proposed marks, displayed below:

²⁴ *Id.* at TSDR 3, 5

²⁵ October 19, 2018 Final Office Actions at TSDR 1 (Serial Nos. 87207915, 87207919, and 87207921).

Serial Nos. 87207915, 87207919, and 87207921 (Consolidated)



26

²⁶ April 19, 2019 Requests for Reconsideration at TSDR 2-3 (Serial Nos. 87207915, 87207919, and 87207921).

II. Analysis of Failure-to-Function Refusals

A. Applicable Law

“It is well settled that terms used merely as model, style, or grade designations are not registrable as trademarks because they do not serve to identify and distinguish one party’s goods from similar goods manufactured and/or sold by others.” *In re Dana Corp.*, 12 USPQ2d 1748, 1749 (TTAB 1989). “This is so because such a designation serves as a description of the product, informing one of the quality, size or type of the particular product, rather than serving as an identifier of the source of the goods.” *Id.* If a proposed mark is found to be a model number or designation, and “it is shown that the designation in question has attained recognition by the public as a source identifier, in addition to any other function it may perform, then it may be registrable as a trademark.” *Id.* (citing *In re Peterson Mfg. Co.*, 229 USPQ 466 (TTAB 1986)).²⁷ The determination of whether a proposed mark is unregistrable because it is a model, style, or grade designation is a question of fact. *Id.*

“[T]he central question in determining whether [each of] Applicant’s proposed mark functions as a [trademark] is the commercial impression it makes on the relevant public (e.g., whether the term sought to be registered would be perceived as a mark identifying the source of the [goods]).” *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1879 (TTAB 2017).

²⁷ We discuss below Applicant’s claim in its briefs that it is entitled to registration of its proposed marks because they have acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

B. Arguments of Applicant and the Examining Attorney

1. Applicant's Arguments

Applicant's arguments are as follows:

Not all alphanumeric designations are all part numbers for the sake of indexing. Some can be the Make and/or Model of a final product of a commodity in commerce, especially in our case of being sold on the market for industrial applications, since May 8, 2008. Applicant respectfully acknowledges the Examiners case, that some alphanumeric designations merely serve as a model designation, but let it be known that our mark MR1109 is no different from (APPLICANT) Daimler AG (owner of MERCEDES BENZ) being awarded the Trademark of model S550E, per (Serial Number: 86393526) to help distinguish it from competitors, and not merely as model designation.

In the alternative, Applicant is entitled to registration of its mark pursuant to *Trademark Act § 2(f)*, on the basis that *the mark has acquired distinctness due to continuous use and exposure of the mark in commerce for the five years before the date of which the claim of distinctiveness is made.* See screenshot attachment of website [mcrmotorusa.com] advertising mark MR1109 [as] early as January 11, 2012, via internet archive, WAYBACKMACHINE.ORG.

4 TTABVUE 7 (emphasis in original).

2. The Examining Attorney's Arguments

The Examining Attorney argues that each of the applied-for marks “merely identifies a model designation because the mark is displayed in ordinary plain font with no stylization, in small type, and is placed on the goods and their packaging on the specimens in such a manner that consumers would likely perceive as merely a model designation.” 7 TTABVUE 5. She argues that the “specimens of record show the mark on the goods; on an advertisement for the goods; and on a display associated

with the goods,” *id.* at 6, and that all of these uses are as model numbers, not marks. *Id.* at 6-7. She argues that “model designations are commonly used to distinguish between different types of automobile parts within a single product line,” *id.* at 6 (citing *Dana Corp.*, 12 USPQ2d at 1749); that Applicant “acknowledges in their [sic] own arguments that [each] mark is a ‘part number;’” *id.* at 7; that each part number is part of what Applicant calls its “1100 series” of automobile parts; and that the record shows that “sellers reference [each] applied-for mark as a model designation and not as source-indicating for the identified goods.” *Id.* She rejects Applicant’s reliance on Mercedes-Benz’s registration of the mark S550E because it is not of record and because each application must be considered on its own merits. *Id.* at 8.

With respect to Applicant’s asserted Section 2(f) claim, the Examining Attorney argues that Applicant “asserted, for the first time, in its appeal brief, a claim of acquired distinctiveness,” but that “this assertion is insufficient to obviate the refusal as it is both untimely and not properly supported by evidence, and should not be considered on appeal.” *Id.* She argues that Applicant “was advised on multiple occasions that a Section 2(f) claim, backed by evidence relating to consumer perception of the applied-for mark as a source indicator, could be proffered,” but that “rather than proffering such evidence prior to the filing of its appeal, applicant improperly asserts the Section 2(f) claim in its brief.” *Id.* at 8.

The Examining Attorney argues in the alternative that Applicant “failed to provide sufficient evidence that the mark has become distinctive of applicant’s goods

in commerce thus, its allegation of five years' use, even if timely, is insufficient to show acquired distinctiveness." *Id.* at 9.

C. Analysis of Refusal

1. Applicant's Asserted Acquired Distinctiveness Claim

As discussed above, Applicant claims on appeal that its marks are registrable even though they are model numbers because they have acquired distinctiveness under Section 2(f). The Examining Attorney twice advised Applicant during prosecution that an option for responding to the model number refusals was "[c]laiming **acquired distinctiveness** under Trademark Act Section 2(f) by submitting **evidence** that the applied for mark has become distinctive of applicant's goods in commerce."²⁸ Applicant merely argued that "[i]n the last 8 years, we have established a positive reputation in our industry for our part number . . . on the basis of performance and high reliability,"²⁹ and that "we have established a recognized and referenced part number in our specialized industry [and] we are no longer a mere model designation,"³⁰ but never amended its applications to seek registration under Section 2(f), even in the alternative. We agree with the Examining Attorney that Applicant's

²⁸ March 28, 2018 Office Actions at TSDR 1 (Serial Nos. 87207915, 87207919, and 87207921) (emphasis in original); October 19, 2018 Final Office Actions at TSDR 1 (Serial Nos. 87207915, 87207919, and 87207921) (emphasis in original).

²⁹ August 7, 2017 Responses to Office Actions at TSDR 1 (Serial Nos. 87207915, 87207919, and 87207921). This argument was made before the Examining Attorney issued the failure-to-function refusals.

³⁰ September 25, 2018 Responses to Office Actions at TSDR 1 (Serial Nos. 87207915, 87207919, and 87207921).

invocation of Section 2(f) on appeal is untimely, and we have given it no consideration. *In re Integrated Embedded*, 120 USPQ2d 1504, 1511-12 (TTAB 2016).³¹

2. Status of Proposed Marks as Model Numbers

Applicant acknowledges that the proposed marks are parts numbers, 4 TTABVUE 7, and its website characterizes the motors labelled with the proposed marks as part of “[o]ur durable MR1100 Series Stepper Motors,”³² and states that “the MR1107, MR1108, and MR1109 Series Stepper Motors can be utilized for replacing defective Switer XC5.168, X15.168, X25.166, X25.168, X25.288, X25.569, XC5.589, X15.589. X25.589, X25.689, X27.168, X27.589 [parts].”³³ The proposed marks appear on Applicant’s specimens in nondescript block lettering, together with other similar lettering, in a manner befitting parts numbers, not marks:



34

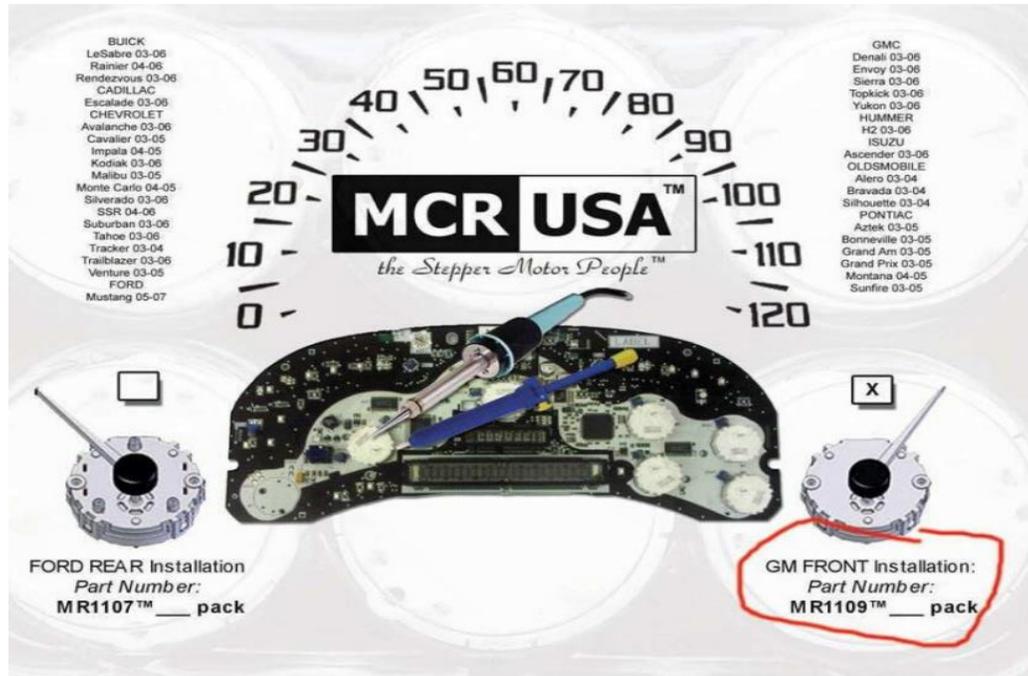
³¹ Applicant’s bald claims of acquired distinctiveness are insufficient in any event. *See Dana Corp.*, 12 USPQ2d at 1750 (statements of seven of applicant’s customers and distributors that they recognized applicant’s parts numbers as source indicators insufficient to establish acquired distinctiveness); *cf. Petersen Mfg.*, 229 USPQ at 467-68 (“a large number of declarations” of retail consumers of applicant’s goods averring that parts numbers were recognized as applicant’s marks sufficient to establish acquired distinctiveness).

³² March 28, 2018 Office Actions at TSDR 3 (Serial Nos. 87207915, 87207919, and 87207921).

³³ *Id.*

³⁴ February 28, 2018 Request for Reconsideration at TSDR 2-3 (Serial No. 87207915).

The proposed marks are also expressly identified as parts numbers on the backs of Applicant's packaging:



35

It is thus hardly surprising that, as shown above, resellers of Applicant's goods uniformly identify, or use, the proposed marks solely as numbers for parts in Applicant's "1100 Series." The record is simply devoid of any evidence that anyone other than Applicant considers the proposed marks to be source-identifiers rather than indicators of product compatibility in automotive production and repair.³⁶

³⁵ April 19, 2019 Requests for Reconsideration at TSDR 2-3 (Serial Nos. 87207915, 87207919, and 87207921) (emphasis supplied by Applicant). Applicant uses the designation TM together with the proposed marks on the packaging and in accompanying displays, *id.* at TSDR 2-3, but "the mere use of TM or 'trademarked' does not automatically transform a word, design, color, or sound into a trademark." *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1701 n.16 (TTAB 2009) (citing *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1864 (TTAB 2006)).

³⁶ As noted above, Applicant cites a purported registration of "model S550E" as a basis for registration of its proposed marks. 4 TTABVUE 7. The registration is not of record, but even if it were, it is axiomatic that each application must be decided on its own facts. *See, e.g., In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016).

We find on the basis of the record as a whole that “the term[s] sought to be registered would [not] be perceived as [marks] identifying the source of the [goods].”

Keep A Breast Found., 123 USPQ2d at 1879.

Decision: The three refusals to register are affirmed.